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SHAH, AMEE A				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/689,133

Applicant(s)

AARON ET AL.

Examiner

AMEE A. SHAH

Art Unit

3625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 April 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/ICE)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Claims 1-24 are pending in this action.

Specification

The use of the trademarks MICROSOFT OUTLOOK and ACTIVEX has been noted in this application. It should be capitalized wherever it appears and be accompanied by the generic terminology.

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 8 and 9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 8 and 14 recite the limitation “wherein the electronic activities includes accessing a personal information calendar.” It is not clear to one of ordinary skill in the art what is meant by this limitation as “electronic activities” is a noun describing an item, i.e. an activity, whereas “accessing” is a verb which cannot further limit an item. Assuming arguendo that the step of accessing is to limit a step of the method of claim 1, it is not clear which step this

is limiting, i.e. the gathering step or analyzing step. For purposes of this action, claim 8 will be interpreted as the gathering of electronic activities including accessing a personal information calendar. Since claim 9 is a dependency of claim 8, it inherits the same deficiencies, is rejected on the same bases, and is interpreted in the same manner.

Claim Rejections - 35 U.S.C. § 103

The following is a quotation of 35 U.S.C. §103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. §103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. §103(c) and potential 35 U.S.C. §102(e), (f) or (g) prior art under 35 U.S.C. §103(a).

Claims 1-4, 6, 7, 10-13 and 19-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Miller et al., US 2002/0046093 A1, previously cited (hereafter referred to as “Miller”) in view of Lucas, US 2001/0051905 A1, previously cited (hereafter referred to

as “Lucas”) and further in view of Maislin, US 2002/0120712 A1 (hereafter referred to as “Maislin”).

Referring to claim 1, Miller teaches a method for automating recurrent electronic transactions conducted over a network, comprising:

- gathering, by a purchasing system, data from an application executing on a computer device in response to electronic activities conducted by a network user of the computer device (¶¶0131 and 0251 - note that the system of the invention gathers from the web browser, i.e. an application executing on a computer device, the user's activities on the site, i.e. in response to electronic activities conducted by the network user of the computer device from an application executing on the computer device, i.e. the web browser);

- performing, via the purchasing system, analysis of the electronic activities (¶¶0131, 0132 and 0191); and

- the purchasing system inferring an intent to execute a transaction by said network user without any explicit action by the user to execute the transaction (¶¶00126-00131 - note that the system analyzes the user history to give product information and promotions based on an inferred intent to purchase a particular product in the future without the user explicitly requesting information on that particular product);

- wherein the analysis includes:

- comparing the electronic activities with previously-conducted electronic activities by the network user (¶¶0132-0134 and 0192); and
- applying user-defined policies to the electronic activities (¶¶0159 and 0163 – note the user-defined policies are the requirements for product attributes and vendors).

While Miller teaches inferring an intent to execute a transaction, it does not specifically teach the purchasing system automatically executing the transaction on behalf of the user including executing a purchase of a service/product on behalf of the network user. Lucas teaches a system and method for monitoring inventory wherein the server electronically tracks and evaluates usage habits and automatically executes on behalf of the customer, i.e. network user, a purchase transaction for items needed (¶¶0026, 0082 and 0085-0087).

It would have been obvious to one of ordinary skill in the art of business methods at the time of the invention to include in the commerce method of Miller the ability to automatically execute on behalf of the user the purchase transaction inferred from the user, as taught by Lucas, since the claimed invention is merely a combination of old elements, and in the combination each element would have performed the same function as it did separately, and one ordinary skill in the art would have recognized that results of the combination were predictable.

The examiner notes that the transitional phrase “includes” is “open-ended and does not exclude additional, unrecited elements of method steps.” (MPEP §2111.03.) As such, Miller teaches comparing the electronic activities with previously-conducted electronic activities by the network user and other users. However, the expedite prosecution, the examiner will consider applicant's arguments (Remarks of April 13, 2009), and will apply art interpreting the limitation of comparing activities as only comparing the activities with that of the network user, and not others, which Miller does not explicitly teach.

However, Maislin teaches a method and system for providing information to a user based on search patterns including the known techniques of gathering user electronic activities and comparing those activities with previously-conducted electronic activities by the network user (¶¶0035-0039). This known technique is applicable to the method of Miller/Lucas as they all share characteristics and capabilities, namely they are directed to providing users information and facilitate shopping.

One of ordinary skill in the art would have recognized that applying the known technique of Maislin would have yielded predictable results and resulted in an improved method. It would have been recognized that applying the known technique of Maislin to the teachings of Miller/Lucas would have yielded predictable results because the level of ordinary skill in the art demonstrated by the references applies shows the ability to incorporate such references into similar methods. Further, using only the user's previously activities, as taught by Maislin, in the analysis of Miller/Lucas would have been recognized by those of ordinary skill in the art as resulting in an improved method that would allow for a better result between what the user is searching or desiring and the results or recommendations given, as suggested by Maislin (¶0038).

Referring to claim 2, Miller/Lucas/Maislin further teaches the method of claim 1 wherein said electronic activities include at least one of accessing a web site, performing a detectable user action on a web page, drafting an email, searching a web-based electronic search engine, entering a new task or accessing an existing task in an electronic task folder, and creating,

editing, or viewing a document (Miller, ¶¶0131 and 0191 – note the electronic activities can be accessing a website, performing a detectable user action, or searching a search engine).

Referring to claim 3, Miller/Lucas/Maislin further teaches the method of claim 1 wherein said comparing said electronic activities with previously-conducted electronic activities further comprises:

- collecting data entered by said network user (Miller, ¶0130 and Lucas, ¶¶0082 and 0085);
- parsing said data by comparing said data to data stored in a database in communication with the purchasing system that contain said previously-conducted electronic activities, said parsing resulting in a suggested electronic transaction for execution (Miller, ¶¶0131, 0132, 0191, 0192 and 0251 – note the suggested electronic transactions are the related products available for purchase, and Lucas, ¶¶0082 and 0085);
- searching said database for related resources associated with said suggested electronic transaction (Miller, ¶¶0131 and 0132 – note the related resources are the related products, and Lucas, ¶¶0082 and 0085); and
- searching a profile database in communication with the purchasing system storing policies and rules created by said network user, said policies and rules operable for specifying conditions for authorizing and executing said suggested electronic transaction (Miller, ¶¶0141, 0161-0164 and 0251);
- wherein said policies and rules include at least one of placing an upper limit on an amount of money that is authorized to be spent on a transaction, placing a time limit on when a

transaction may be executed, prescribing authorized vendors, suppliers, or entities through which a transaction may be entered, and specifying delivery options for items and services associated with a transaction (Miller, ¶¶0141 and 0161-0164 – note the policies and rules are prescribing certain vendors based on geographic location and specifying delivery options such as availability of delivery).

Referring to claim 4, Miller/Lucas/Maislin further teaches the method of claim 3 further comprising the purchasing system searching a service/product database in communication with the purchasing system to ensure said items and services associated with said transaction are available (Miller, ¶¶0155 and 0164).

Referring to claims 6 and 7, Miller/Lucas/Maislin further teaches the method of claim 1 comprising the purchasing system generating an electronic invoice upon execution of said transaction (Miller, ¶0184 – note the shopping cart is the electronic invoice), and notifying said network user that said transaction has been completed via an email program on the computer device (Miller, ¶0235).

Referring to claims 10-13 and 19-22, all of the limitations in apparatus claims 10-13 and 19-22 are closely parallel to the limitations of method claims 1-4, analyzed above, and are rejected on the same bases.

Claims 5 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Miller/Lucas/Maislin, as applied to claim 3, and further in view of Agrawal et al., 6,061,682, previously cited (hereafter referred to as “Agrawal”).

Referring to claim 5, Miller/Lucas/Maislin teaches the method of claim 3 but does not specifically teach the purchasing system searching a service/product database in communication with the purchasing system to ensure that said items and services associated with said transaction are compatible with said transaction. Agrawal teaches a method of creating associations between products including searching databases to ensure that items and services are compatible with the transaction, i.e. product (see, e.g., col. 3, lines 25-37).

It would have been obvious to one of ordinary skill in the art of business methods at the time of the invention to combine the known elements of searching a database to ensure products are compatible, as taught by Agrawal, with the known elements of analyzing user data, parsing data and searching for suggested related products, as taught by Miller/Lucas/Maislin, as each element would have performed the same function in combination as it did separately. One ordinary skill in the art would have recognized that the combination of Agrawal and Miller would yield the predictable results of producing economic value to advertisers by providing associations that are more likely to lead to sales, as suggested by Agrawal (col. 3, lines 25-37).

Referring to claim 14, Miller/Lucas/Maislin teaches the system of claim 12 further comprising the purchasing system generating an electronic invoice upon execution of said transaction (Miller, ¶0184 – note the shopping cart is the electronic invoice), and notifying said

network user that said transaction has been completed via an email program on the computer device (Miller, ¶0235), but does not specifically teach the purchasing system searching a service/product database in communication with the purchasing system to ensure that said items and services associated with said transaction are compatible with said transaction. Agrawal teaches a method of creating associations between products including searching databases to ensure that items and services are compatible with the transaction, i.e. product (see, e.g., col. 3, lines 25-37).

It would have been obvious to one of ordinary skill in the art of business methods at the time of the invention to combine the known elements of searching a database to ensure products are compatible, as taught by Agrawal, with the known elements of analyzing user data, parsing data and searching for suggested related products, as taught by Miller/Lucas/Maislin, as each element would have performed the same function in combination as it did separately. One ordinary skill in the art would have recognized that the combination of Agrawal and Miller would yield the predictable results of producing economic value to advertisers by providing associations that are more likely to lead to sales, as suggested by Agrawal (col. 3, lines 25-37).

Claims 8, 9, 18 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Miller/Lucas/Maislin, as applied to claim 1, and further in view of Keskar et al., US 2004/0259536 A1 (hereafter referred to as “Keskar”).

Referring to claim 8, Miller/Lucas/Maislin teaches the method of claim 1, but does not teach wherein the electronic activities includes accessing a personal information calendar. Keskar teaches a method and system for gathering information pertaining to the user's

surroundings including the known technique of accessing personal calendar information (e.g. ¶0013). This known technique is applicable to the method of Miller/Lucas/Maislin as they all share characteristics and capabilities, namely they are directed to providing users information and facilitate shopping.

One of ordinary skill in the art would have recognized that applying the known technique of Keskar would have yielded predictable results and resulted in an improved method. It would have been recognized that applying the known technique of Keskar to the teachings of Miller/Lucas/Maislin would have yielded predictable results because the level of ordinary skill in the art demonstrated by the references applies shows the ability to incorporate such references into similar methods. Further, accessing calendar information, as taught by Keskar, as the electronic activities of Miller/Lucas/Maislin would have been recognized by those of ordinary skill in the art as resulting in an improved method that would allow for a better result between what the user is searching or desiring and the results or recommendations given.

Referring to claim 9, Miller/Lucas/Maislin/Keskar further teaches the method of claim 8 wherein the previously-conducted electronic activities include an occurrence of a meeting scheduled into the personal information calendar and including parameters comprising, a number of participants, a meeting location, a time of day, and meeting resources and materials, a web site search, an electronic purchase, an email message received or transmitted by said network user, a calendar item generated or accessed by said network user, and a task item generated or accessed by said network user (Keskar, ¶0013 – note the parameters of the meeting include meeting location).

Referring to claims 18 and 24, all of the limitations in apparatus claims 18 and 24 are closely parallel to the limitations of method claim 9, analyzed above and are rejected on the same bases.

Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Miller/Lucas/Maislin, as applied to claim 10, and further in view of McLauchlin et al., US 2001/0011222 A1 (hereafter referred to as “McLauchlin”).

Referring to claim 15, Miller/Lucas/Maislin teaches the storage medium of claim 10, but does not teach wherein the policies and rules include at least one of placing an upper limit on an amount of money that is authorized to be spent on a transaction and placing a time limit on when a transaction may be executed. McLauchlin teaches a system, storage medium and method for integrated procurement whereby personnel wishing to purchase items must do so within policies and procedures set by the employer as applied to the purchases including the known technique of applying the policy of placing an upper limit on an amount of money that is authorized to be spent on a transaction (e.g. ¶¶0087-0093). This known technique is applicable to the medium of Miller/Lucas/Maislin as they all share characteristics and capabilities, namely they are directed to facilitating shopping.

One of ordinary skill in the art would have recognized that applying the known technique of McLauchlin would have yielded predictable results and resulted in an improved method. It would have been recognized that applying the known technique of McLauchlin to the teachings of Miller/Lucas/Maislin would have yielded predictable results because the level of ordinary skill

in the art demonstrated by the references applies shows the ability to incorporate such references into similar methods. Further, applying the policy of an upper limit, as taught by McLauchlin, to the policies of Miller/Lucas/Maislin would have been recognized by those of ordinary skill in the art as resulting in an improved method that would allow for a better result between what the user is searching or desiring and the results or recommendations given.

Claims 16, 17 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Miller/Lucas/Maislin/McLauchlin, as applied to claim 15, and further in view of Official Notice, as admitted by applicant to be prior art.

Referring to claims 16 and 17, Miller/Lucas/Maislin/McLauchlin teaches the medium of claim 15 wherein said notification is sent via email and wherein graphical user interfaces can be used instead (Miller, ¶0279). While Miller does not explicitly teach that notification can be done using an application programming interface, it was old and well known at the time of the invention to use application programming interfaces with graphical user interfaces to send notifications. One of ordinary skill in the art would have done so for the predictable result of having a more user-friendly notice. Since applicant did not traverse the official notice in previous office actions, applicant has admitted that use of a GUI is prior art.

Referring to claim 23, all of the limitations in apparatus 23 are closely parallel to the limitations of apparatus claim 16, analyzed above, and are rejected on the same bases.

Response to Amendment

Applicant's amendment, filed April 13, 2009, has been entered. Claims 1-10, 12, 14, 15 and 19 have been amended. In view of the amendments, the rejections of claim 1-9 under 35 USC §101 are withdrawn.

Response to Arguments

Applicant's arguments, filed April 13, 2009, with respect to claim 1- 24 have been considered but are moot in view of the new ground(s) of rejection. However, the examiner addresses those still relevant. In response to applicant's argument with respect to independent claims 1, 10 and 19 that Miller does not teach an analysis of a particular network user based upon the user's own electronic-based activities (Remarks, pages 13-15), it is noted that this feature is not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). As discussed above, the examiner directs applicant's attention to MPEP 2111.03 that states the transition phrase "include" is open-ended and does not exclude other elements. Thus, Miller's teaching of using the user's own activities as well as activities of others teaches the limitations of the claims. However, as also discussed above, the expedite prosecution, the examiner has provided prior art that teaches this limitation as intended by the applicant.

Applicant's arguments with respect to claim 8 (Remarks, page 15) have been considered but are moot in view of the new ground(s) of rejection.

Applicant's arguments with respect to claim 15 (Remarks, page 17) have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to AMEE A. SHAH whose telephone number is (571)272-8116. The examiner can normally be reached Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey A. Smith can be reached on 571-272-6763. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Jeffrey A. Smith/
Supervisory Patent Examiner, Art Unit
3625

AAS

June 23, 2009